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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,710	01/02/2004	Stephen P. DeLisle	9438-2	4095
20792	7590	07/05/2005	EXAMINER	
MYERS BIGEL SIBLEY & SAJOVEC			WONG, STEVEN B	
PO BOX 37428			ART UNIT	PAPER NUMBER
RALEIGH, NC 27627			3711	

DATE MAILED: 07/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/750,710	DELISLE ET AL.
	Examiner Steven Wong	Art Unit 3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 06 April 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-6,8-10 and 12-43 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-6,8-10 and 12-43 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/27/05</u> | 6) <input type="checkbox"/> Other: _____ |

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

1. Claims 1-4, 8-10, 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Hodges (1,645,001) in view of Clausing (1,644,979). Regarding claim 1, Hodges discloses a golf tee comprising an elongate shaft (10) and a support cup (11). The support cup has a discontinuous annulus (note Figure 2) defining three arcuate support prongs (15). Note Figure 1 showing a concave upper surface for the base portion.

Clausing discloses a golf tee including a concave support surface (8) that does not contact a golf ball (note Figure 3). It would have been obvious to one of ordinary skill in the art to form the golf tee of Hodges with a radius of curvature for the support surface such that the golf ball only contacts the prongs in order to minimize the resistance to the golf ball at the moment of departure from the tee.

Regarding claim 2, the prongs (15) of Hodges appear to be of a secant length that is greater than a dimple of a conventional golf ball. In the alternative, even though Hodges does not disclose for his dimples to not fit within the dimples of a golf ball, it would have been obvious to one of ordinary skill in the art to form the prongs of a length greater than a golf ball dimple in order to firmly support a golf ball.

Regarding claims 3, 4 and 10, the recited secant length and taper angle are considered to be obvious given the teachings of Hodges and the lack of a teaching for the claimed dimensions'

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criticality by the demonstration of a new and unexpected result obtained therefrom. Regarding claim 8, Hodges includes flutes (18) in the shaft.

Regarding claim 9, note Figure 1 showing the shaft decreasing in diameter along the length.

Regarding claims 12 and 13, Hodges discloses for his tee to be formed from a biodegradable material.

2. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hodges (1,645,001) in view of Clausing (1,644,979) and Dawson, Jr. (2,693,358). Regarding claim 5, Hodges lacks the teaching for support prongs to comprise a convex contact surface with the golf ball.

Dawson, Jr. reveals a golf tee construction including a contact surface for a golf ball.

Note Figures 2 and 3a showing a non-convex contact surface (5) and a convex contact surface (15). Note also column 2, lines 52-54 stating that the convex contact surface provides a better seat for a golf ball. Thus, it would have been obvious to one of ordinary skill in the art to form the prongs of Hodges with a convex contact surface in order to better support a teed golf ball.

3. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hodges (1,645,001) in view of Clausing (1,644,979) and Seager (2,455,705). Seager discloses a golf tee construction including a plurality of prongs that support a golf ball. Note Figures 1 and 3 showing that both three and four configurations are known in the art. It would have been obvious to one of ordinary skill in the art to form the golf tee of Hodges with four prongs as Seager teaches that golf tees with three or four prongs are considered to be equivalents in the art

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and one of ordinary skill in the art would have found it obvious to substitute four prongs for three prongs in the golf tee.

4. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hodges (1,645,001) in view of Clausing (1,644,979) and Tan (6,710,135). Tan discloses a biodegradable golf tee construction including a polylactic acid. It would have been obvious to one of ordinary skill in the art to form the tee of Hodges with a polylactic acid for the reasons advanced by Tan.

5. Claims 15-19, 22-27, 29-33, 36-40, 42 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hodges (1,645,001) in view of Dawson, Jr. (2,693,358). Regarding claims 15 and 29, note the rejections of claims 1, 2 and 5 above.

Regarding claims 16, 17, 23, 24, 30, 31, 37 and 38, note the rejection of claims 3, 4, 9 and 10.

Regarding claims 18, 19, 32 and 33, the recited radii of curvature for the contact surfaces is considered to be obvious given the teachings of Hodges in view of Dawson, Jr. and the lack of a teaching for the claimed dimensions' criticality by the demonstration of a new and unexpected result obtained therefrom.

Regarding claims 22 and 36, note the rejection of claim 8.

Regarding claims 25, 26, 39 and 40, note the rejections of claims 12 and 13.

Regarding claims 27 and 42, note the rejection of claim 1.

Regarding claim 43, note the rejections of claims 1, 2 and 5. Further, the recited dimension for the contact area between the contact surfaces and the golf ball resting on the contact surfaces is considered to be obvious given the teachings of Hodges in view of Dawson

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and the lack of a demonstration for the criticality of the claimed dimension by a new and unexpected result obtained therefrom.

6. Claims 20 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hodges (1,645,001) in view of Dawson, Jr. (2,693,358) and Seager (2,455,705). Note the rejection of claim 6.

7. Claims 21 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hodges (1,645,001) in view of Dawson, Jr. (2,693,358) and Clausing (1,644,979). Note the rejection of claim 1.

8. Claim 28 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hodges (1,645,001) in view of Dawson, Jr. (2,693,358) and Tan (6,710,135). Note the rejection of claim 14.

Response to Arguments

9. Applicant's arguments filed April 6, 2005 have been fully considered but they are not persuasive. Regarding the rejection of claims 1, 8, 9 and 11-13 under 35 U.S.C. 102(b), the applicant is requested to note that that rejection has been withdrawn and the claims are now rejected over the combination of Hodges in view of Clausing (1,644,979). The applicant argues that Hodges does not teach an upper face that would avoid contact with the surface of a seated golf ball. This argument is not persuasive as the rejection is now over the combination of Hodges in view of Clausing. Clausing clearly shows (note Figures 3 and 7) a seated golf ball that does not contact the upper surface of the ball seat and wherein only the prongs support the golf ball. Further, Clausing states that this arrangement is desirable because it limits the frictional contact between the ball and the tee. Thus, it would have been obvious to one of

ordinary skill in the art to alter the upper surface of the ball cup so that the seated ball only contacts the prongs in order to limit the amount of frictional contact between the ball and the tee.

Regarding the citation of Hodges at page 1, lines 100-108, this citation is seen as relating to the advantages associated with the notches (14) and the spaced sections (15) and their engagement with the seated golf ball. Absent in the citation is an express statement that the upper surface of the tee is formed with a radius of curvature that conforms to the surface of a golf ball. Further, absent in the citation is any express statement that the tee would fail to function if it was modified as set forth above with the teachings of Clauising.

Regarding the reference to Dawson, Jr., the applicant argues that the teachings of Dawson, Jr. for a convex contact area would not be combinable with the teachings of Hodges. However, this is not persuasive as Dawson, Jr. lists advantages for the convex contact area that would be desirable for the tee of Hodges. Note column 2, lines 56-59 of Dawson, Jr. stating that the convex surface provides a better seat for the golf ball. Clearly, improved seating of the ball would be desirable for the tee of Hodges. Further, this advantage can be equated to the citation of Hodges stating the desirability for a secure seating of the ball.

Regarding the applicant's statement that it is not entirely clear from Figure 3a of Dawson that the ball would actually rest on the bead, the combination fo Hodges in view of Dawson, Jr. would obviously provide a "convex contact surface adapted to contact a golf ball". The claims merely recite a convex contact surface for the prongs, they do not preclude the inclusion of other features for the prongs that may also contact the golf ball. Further, the instant claims only state that the prongs present a convex contact surface for contacting a golf ball. Even if the seated ball rests on the upper edges of the tube (12) as applicant argues, the limitations of the claim are still

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met by the combination as convex contact surfaces are still presented the are capable of contacting a golf ball.

10. In response to applicant's argument that the combination of Hodges in view of Dawson, Jr. does not teach the inclusion of convex contact surfaces for the same reasons as recited in claims 15, 29 and 43, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

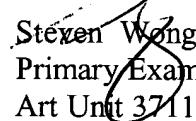
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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 571-272-4416. The examiner can normally be reached on Monday through Friday 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Steven Wong
Primary Examiner
Art Unit 3711

SBW
June 21, 2005